REMARKS

Claims 4-8 and 17-29 are pending in the Application. Figure 4 is objected to. Claims 22 and 24 are objected to. Claims 4-8 and 17-21 are rejected under 35 U.S.C. §101. Claims 4-8 and 17-29 are rejected under 35 U.S.C. §103(a).

Applicants address these objections and rejections below.

Applicants thank the Examiner for discussing the 35 U.S.C. §101 rejections with Applicants' attorney on October 31, 2006.

I.   OBJECTIONS TO THE DRAWINGS:

The Examiner has objected to Figure 4 for including numerical labels without associated textual labels that would better clarify the nature of the invention. Office Action (8/9/2006), page 2. Applicants amended Figure 4 by including the textual label of "status display" on Figure 4 to better clarify element 401 as indicated above. Accordingly, Applicants respectfully request the Examiner to withdraw the objections to the drawings.

II.   OBJECTIONS TO THE CLAIMS:

The Examiner has objected to claim 22 for including the typographical mistake of "wheren" instead of "wherein." Office Action (8/9/2006), page 2. The Examiner has further objected to claim 24 for including the typographical mistake of "reicted" instead of "recited." Applicants appropriately amended claims 22 and 24 to correct the typographical mistakes as indicated above.

Applicants note that claims 22 and 24 were not amended to overcome prior art but to correct typographical mistakes. Hence, no prosecution history estoppel arises from the amendments to claims 22 and 24. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 22 and 24 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

III.   REJECTIONS UNDER 35 U.S.C. §101:

The Examiner rejects claims 4-8 and 17-21 under 35 U.S.C. §101 as being directed to non-statutory subject matter. In particular, the Examiner rejects claims 4-8 under 35 U.S.C. §101 because the method steps claimed in claims 4-8 can allegedly be practiced mentally in conjunction with pen and paper. Office Action (8/9/2006), page 3. That is, the Examiner rejects claims 4-8 because the claims do not produce a tangible result. *Id.* Furthermore, the Examiner rejects claims 17-21 under 35 U.S.C. §101 because the claims are allegedly not limited to tangible embodiments. *Id.* While Applicants believe that claims 4-8 and 17-21 as previously written are directed to statutory subject matter, Applicants amended claims 4 and 17 as suggested by the Examiner on page 3 of the Office Action to further prosecution. Applicants respectfully request the Examiner to withdraw the rejections under 35 U.S.C. §101.

IV.   REJECTIONS UNDER 35 U.S.C. §103(a):

The Examiner has rejected claims 4-8 and 17-29 under 35 U.S.C. §103(a) as being unpatentable over Crisan (U.S. Patent No. 6,292,890) in view of Lewis (U.S. Patent No. 6,078,306). Applicants respectfully traverse these rejections for at least the reasons stated below, and respectfully request the Examiner to reconsider and withdraw these rejections.

      A.   Crisan and Lewis, taken singly or in combination, do not teach or suggest the following claim limitations.

Applicants respectfully assert that Crisan and Lewis, taken singly or in combination, do not teach or suggest "determining if configuration of a device has begun" as recited in claim 4 and similarly in claims 17 and 25. The Examiner cites column 1, line 64 – column 2, line 10 of Crisan as teaching the above-cited claim limitation. Office Action (8/9/2006), page 4. Applicants respectfully traverse.

Crisan instead teaches that if the BIOS supports the Plug and Play standard, the CPU will detect and configure Plug and Play devices at this time and display a message on the screen for each one it finds. Column 2, lines 5-8. Hence, Crisan teaches detecting and configuring Plug and Play devices. However, there is no language in the cited passage that teaches determining if configuration of a device has begun. Therefore, the Examiner has not presented a *prima facie* case of obviousness

in rejecting claims 4, 17 and 25, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Crisan and Lewis, taken singly or in combination, do not teach or suggest "if configuration of a device has begun, inserting the configuration of the device in a list and displaying a code associated with the device" as recited in claim 4 and similarly in claims 17 and 25. The Examiner cites column 2, lines 5-8 of Crisan as teaching the above-cited claim limitation. Office Action (8/9/2006), page 4. Applicants respectfully traverse.

Crisan instead teaches that if the BIOS supports the Plug and Play standard, the CPU will detect and configure Plug and Play devices at this time and display a message on the screen for each one it finds. Column 2, lines 5-8. Hence, Crisan teaches detecting and configuring Plug and Play devices and displaying a message on a screen for each Plug and Play device it finds. This is not the same as inserting the configuration of the device in a list and displaying a code associated with the device. Neither is there any language in the cited passage that teaches inserting the configuration of the device in a list and displaying a code associated with the device if configuration of a device has begun. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 4, 17 and 25, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Crisan and Lewis, taken singly or in combination, do not teach or suggest "if configuration of a device has completed, removing the configuration of the device from the list" as recited in claim 4 and similarly in claims 17 and 25. The Examiner cites column 1, lines 49-52 of Lewis as teaching the above-cited claim limitation. Office Action (8/9/2006), pages 4-5. Applicants respectfully traverse and assert that Lewis instead teaches that the status window 16 may display the communication status variables of the program. Column 1, lines 48-50. Lewis further teaches that the text window 14 displays incoming text in the form of rows that scroll upwardly such that new rows can be added to the bottom. Column 1, lines 50-52. There is no language in the cited passage that

teaches removing the configuration of the device from the list. Neither is there any language in the cited passage that teaches removing the configuration of the device from the list if configuration of a device has completed. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 4, 17 and 25, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Crisan and Lewis, taken singly or in combination, do not teach or suggest "if the configuration of the device removed in step (d) had its associated code displayed, displaying code associated with a configuration of a device immediately previous" as recited in claim 4 and similarly in claims 17 and 25. The Examiner cites column 1, lines 49-52 of Lewis as teaching the above-cited claim limitation. Office Action (8/9/2006), pages 4-5. Applicants respectfully traverse. As stated above, Lewis instead teaches that the status window 16 may display the communication status variables of the program. Column 1, lines 48-50. Lewis further teaches that the text window 14 displays incoming text in the form of rows that scroll upwardly such that new rows can be added to the bottom. Column 1, lines 50-52. There is no language in the cited passage that teaches displaying code associated with a configuration of a device immediately previous. Neither is there any language in the cited passage that teaches displaying code associated with a configuration of a device immediately previous if the configuration of the device removed in step (d) had its associated code displayed. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 4, 17 and 25, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Crisan and Lewis, taken singly or in combination, do not teach or suggest "wherein said operating system comprises a configuration manager" as recited in claim 22. The Examiner cites column 1-2 of Crisan as teaching the above-cited claim limitation. Office Action (8/9/2006), page 7. Applicants respectfully traverse and assert that Crisan instead teaches that the CPU resets itself and searches for instructions on how to prepare the system for operation. Column 1, lines 36-37. Crisan further teaches that the initial instructions are known

as the BIOS[1] and are typically found by the CPU in a nonvolatile memory such as a ROM. Column 1, lines 37-40. There is no language in the cited passage that teaches an operating system that includes a configuration manager. A BIOS is not an operating system. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 22, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Crisan and Lewis, taken singly or in combination, do not teach or suggest "wherein said configuration manager comprises logic for inserting a code associated with a first device to a list if a configuration of said first device has begun" as recited in claim 22. The Examiner cites column 2, lines 4-8 of Crisan as teaching the above-cited claim limitation. Office Action (8/9/2006), page 7. Applicants respectfully traverse. Crisan instead teaches that the BIOS will also now instruct the CPU to search for and label logical devices. Column 2, lines 4-5. Crisan further teaches that if the BIOS supports the Plug and Play standard, the CPU will detect and configure Plug and Play devices at this time and display a message on the screen for each one it finds. Column 2, lines 5-8. Crisan additionally teaches that the CPU will often display a summary screen about the system configuration and begin a search for a boot device. Column 2, lines 8-10. There is no language in the cited passage that teaches a configuration manager that includes logic for inserting a code associated with a first device to a list. Neither is there any language in the cited passage that teaches a configuration manager that includes logic for inserting a code associated with a first device to a list if a configuration of the first device has begun. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 22, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Crisan and Lewis, taken singly or in combination, do not teach or suggest "wherein said configuration manager

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[1] BIOS may refer to an essential set of routines stored in a chip that provides an interface between the operating system and the hardware in a PC. See definition of "BIOS" at www.techweb.com/encylopedia.

comprises...logic for displaying said code associated with said first device" as recited in claim 22. The Examiner cites column 2, lines 5-8 of Crisan as teaching the above-cited claim limitation. Office Action (8/9/2006), page 7. Applicants respectfully traverse. Crisan instead teaches that if the BIOS supports the Plug and Play standard, the CPU will detect and configure Plug and Play devices at this time and display a message on the screen for each one it finds. Column 2, lines 5-8. There is no language in the cites passage that teaches a configuration manager that includes logic for displaying code. Neither is there any language in the cited passage that teaches a configuration manager that includes logic for displaying code associated with the first device. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 22, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Crisan and Lewis, taken singly or in combination, do not teach or suggest "wherein said configuration manager comprises...logic for removing said code associated with said first device from said list if said configuration of said first device is completed" as recited in claim 22. The Examiner cites column 1, lines 49-52 of Lewis as teaching the above-cited claim limitation. Office Action (8/9/2006), page 8. Applicants respectfully traverse and assert that Lewis instead teaches that the status window 16 may display the communication status variables of the program. Column 1, lines 48-50. Lewis further teaches that the text window 14 displays incoming text in the form of rows that scroll upwardly such that new rows can be added to the bottom. Column 1, lines 50-52. There is no language in the cited passage that teaches a configuration manager that includes logic for removing code associated with the first device. Neither is there any language in the cited passage that teaches a configuration manager that includes logic for removing code associated with the first device from the list. Neither is there any language in the cited passage that teaches a configuration manager that includes logic for removing code associated with the first device from the list if the configuration of the first device is completed. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 22, since the Office

Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Crisan and Lewis, taken singly or in combination, do not teach or suggest "wherein said configuration manager comprises...logic for displaying code associated with a second device if said code associated with said first device is displayed, wherein said second device was previously configured to said first device" as recited in claim 22. The Examiner cites column 1, lines 49-52 of Lewis as teaching the above-cited claim limitation. Office Action (8/9/2006), page 8. Applicants respectfully traverse. As stated above, Lewis instead teaches that the status window 16 may display the communication status variables of the program. Column 1, lines 48-50. Lewis further teaches that the text window 14 displays incoming text in the form of rows that scroll upwardly such that new rows can be added to the bottom. Column 1, lines 50-52. There is no language in the cited passage that teaches a configuration manager that includes logic for displaying code. Neither is there any language in the cited passage that teaches a configuration manager that includes logic for displaying code associated with a second device. Neither is there any language in the cited passage that teaches a configuration manager that includes logic for displaying code associated with a second device if the code associated with the first device is displayed. Neither is there any language in the cited passage that teaches a configuration manager that includes logic for displaying code associated with a second device if the code associated with the first device is displayed, where the second device was previously configured to the first device. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 22, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Claims 5-8 each recite combinations of features of independent claim 4, and hence claims 5-8 are patentable over Crisan in view of Lewis for at least the above-stated reasons that claim 4 is patentable over Crisan in view of Lewis.

Claims 18-21 each recite combinations of features of independent claim 17, and hence claims 18-21 are patentable over Crisan in view of Lewis for at least the above-stated reasons that claim 17 is patentable over Crisan in view of Lewis.

Claims 23-24 each recite combinations of features of independent claim 22, and hence claims 23-24 are patentable over Crisan in view of Lewis for at least the above-stated reasons that claim 22 is patentable over Crisan in view of Lewis.

Claims 26-29 each recite combinations of features of independent claim 25, and hence claims 26-29 are patentable over Crisan in view of Lewis for at least the above-stated reasons that claim 25 is patentable over Crisan in view of Lewis.

Claims 5-8, 18-21, 23-24 and 26-29 recite additional features, which, in combination with the features of the claims upon which they depend, are patentable over Crisan in view of Lewis.

For example, Crisan and Lewis, taken singly or in combination, do not teach or suggest "returning to step (a) from step (b) if it is determined that configuration of a device has begun" as recited in claim 5 and similarly in claims 18 and 26. The Examiner cites column 2, lines 5-10 of Crisan as teaching the above-cited claim limitation. Office Action (8/9/2006), page 6. Applicants respectfully traverse and assert that Crisan instead teaches that if the BIOS supports the Plug and Play standard, the CPU will detect and configure Plug and Play devices at this time and display a message on the screen for each one it finds. Column 2, lines 5-8. Crisan further teaches that the CPU will often display a summary screen about the system configuration and begin a search for a boot device. Column 2, lines 8-10. There is no language in the cited passage that teaches returning to step (a) (referring to determining if configuration of a device has begun) from step (b) (referring to inserting the configuration of the device in a list and displaying a code associated with the device if configuration of a device has begun) if it is determined that configuration of a device has begun. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 5, 18 and 26, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Crisan and Lewis, taken singly or in combination, do not teach or suggest "returning to step (a) if in step (c) it is determined that configuration of a device has not completed" as recited in claim 6 and similarly in claims 19 and 27. The Examiner cites column 1, lines 50-55 and column 2, lines 5-10 of Crisan as teaching the above-cited claim limitation. Office Action (8/9/2006), page 6. Applicants respectfully traverse and assert that Crisan instead teaches that the text window 14 displays incoming text in the form of rows that scroll upwardly such that new rows can be added to the bottom. Column 1, lines 50-52. Crisan further teaches that if the BIOS supports the Plug and Play standard, the CPU will detect and configure Plug and Play devices at this time and display a message on the screen for each one it finds. Column 2, lines 5-8. Crisan further teaches that the CPU will often display a summary screen about the system configuration and begin a search for a boot device. Column 2, lines 8-10. There is no language in the cited passages that teaches returning to step (a) (referring to determining if configuration of a device has begun) if in step (c) (referring to determining if configuration of a device has completed) it is determined that configuration of a device has not completed. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 6, 19 and 27, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Crisan and Lewis, taken singly or in combination, do not teach or suggest "returning to step (a) if in step (e) the configuration of the device removed in step (d) had not had its associated code displayed" as recited in claim 7 and similarly in claims 20 and 28. The Examiner cites column 2, lines 5-10 of Crisan as teaching the above-cited claim limitation. Office Action (8/9/2006), page 6. Applicants respectfully traverse. As stated above, Crisan instead teaches that if the BIOS supports the Plug and Play standard, the CPU will detect and configure Plug and Play devices at this time and display a message on the screen for each one it finds. Column 2, lines 5-8. Crisan further teaches that the CPU will often display a summary screen about the system configuration and begin a search for a boot device. Column 2, lines 8-10. There is no language in the cited passage that teaches returning to step (a) (referring to determining if configuration of

a device has begun) if in step (e) (referring to displaying code associated with a configuration of a device immediately previous if the configuration of the device removed in step (d) had its associated code displayed) the configuration of the device removed in step (d) (referring to removing the configuration of the device from the list if configuration of a device has completed) had not had its associated code displayed. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 7, 20 and 28, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Crisan and Lewis, taken singly or in combination, do not teach or suggest "returning to step (c) from step (e)" as recited in claim 8 and similarly in claims 21 and 29. The Examiner cites column 2, lines 5-10 of Crisan as teaching the above-cited claim limitation. Office Action (8/9/2006), page 7. Applicants respectfully traverse. As stated above, Crisan instead teaches that if the BIOS supports the Plug and Play standard, the CPU will detect and configure Plug and Play devices at this time and display a message on the screen for each one it finds. Column 2, lines 5-8. Crisan further teaches that the CPU will often display a summary screen about the system configuration and begin a search for a boot device. Column 2, lines 8-10. There is no language in the cited passage that teaches returning to step (c) (referring to determining if configuration of a device has completed) from step (e) (referring to displaying code associated with a configuration of a device immediately previous if the configuration of the device removed in step (d) had its associated code displayed). Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 8, 21 and 29, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Crisan and Lewis, taken singly or in combination, do not teach or suggest "wherein said configuration manager further comprises: logic for displaying code associated with a device located at the top of said list" as recited in claim 23. The Examiner cites column 2, lines 5-10 of Crisan as teaching the above-cited claim limitation. Office Action (8/9/2006), page 9. Applicants respectfully traverse. As stated above, Crisan instead teaches that if the

BIOS supports the Plug and Play standard, the CPU will detect and configure Plug and Play devices at this time and display a message on the screen for each one it finds. Column 2, lines 5-8. Crisan further teaches that the CPU will often display a summary screen about the system configuration and begin a search for a boot device. Column 2, lines 8-10. There is no language in the cited passage that teaches a configuration manager that includes logic for displaying code. Neither is there any language in the cited passage that teaches a configuration manager that includes logic for displaying code associated with a device located at the top of the list. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 23, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicants further assert that Crisan and Lewis, taken singly or in combination, do not teach or suggest "wherein said configuration manager further comprises: logic for displaying code associated with a latest-started device to be configured that has not been completed configuration" as recited in claim 24. The Examiner cites column 2, lines 5-10 of Crisan as teaching the above-cited claim limitation. Office Action (8/9/2006), page 9. Applicants respectfully traverse. As stated above, Crisan instead teaches that if the BIOS supports the Plug and Play standard, the CPU will detect and configure Plug and Play devices at this time and display a message on the screen for each one it finds. Column 2, lines 5-8. Crisan further teaches that the CPU will often display a summary screen about the system configuration and begin a search for a boot device. Column 2, lines 8-10. There is no language in the cited passage that teaches a configuration manager that includes logic for displaying code. Neither is there any language in the cited passage that teaches a configuration manager that includes logic for displaying code associated with a latest-started device to be configured. Neither is there any language in the cited passage that teaches a configuration manager that includes logic for displaying code associated with a latest-started device to be configured that has not been completed configuration. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 24, since the Office Action is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

As a result of the foregoing, Applicants respectfully assert that there are numerous claim limitations not taught or suggested in Crisan in view of Lewis, and thus the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 4-8 and 17-29. M.P.E.P. §2143.

B. Examiner's motivation for modifying Crisan with Lewis to include the missing claim limitation of claims 4, 17 and 25 is insufficient to establish a *prima facie* case of obviousness.

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id*. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id*. In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Crisan does not teach "if configuration of a device has completed, removing the configuration of the device from the list; if the configuration of the device removed in step (d) had its associated code displayed, displaying code associated with a configuration of a device immediately previous" as recited in claim 4 and similarly in claims 17 and 25. Office Action (8/9/2006), pages 4-5. The Examiner asserts that Lewis teaches the above-cited claim limitations. Office Action (8/9/2006), page 5. The Examiner's motivation for modifying Crisan

with Lewis to include the above-cited claim limitations is "for the benefit of conforming with the operational nature of text windows used by the majority of computer systems to outputting BIOS information." Office Action (8/9/2006), page 6. The Examiner's motivation is insufficient to establish a *prima facie* case of obviousness in rejecting claims 4-8, 17-21 and 25-29.

The Examiner has not provided a source for his motivation for modifying Crisan to include the above-cited claim limitations. The Examiner simply states "for the benefit of conforming with the operational nature of text windows used by the majority of computer systems to outputting BIOS information" as motivation for modifying Crisan to include the above-cited claim limitations. The motivation to modify Crisan must come from one of three possible sources: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-48 (Fed. Cir. 1998). <u>Applicants respectfully request the Examiner to point out which of these sources is the source of the Examiner's motivation</u>[2]. The Examiner has not provided any evidence that his motivation comes from any of these sources.

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[2] Applicants respectfully request the Examiner to point out the source of the Examiner's motivation because it appears to Applicants that the Examiner is relying upon his own subjective opinion. The reason why the Federal Circuit (*In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2000)) has required the Examiner to provide objective evidence is because it may be easy to conclude that it would be obvious to combine references using hindsight reasoning even though there is no motivation or suggestion to do so. One can usually find a reason to combine references or make modifications to the main reference. If that were all it took, then all inventions would be obvious and not patentable. For example, assuming that a wheelbarrow had never been developed and a patentee had claimed a wheelbarrow, if the main reference taught a cart with a shallow box body, and the secondary reference taught two wheels, then the Examiner could simply assert, using hindsight reasoning without providing objective evidence, that the motivation for combining the two references is so that the cart could be moved from place to place. Hence, the patentee could not obtain a patent on the wheelbarrow (even though one has never been developed) based on the Examiner's rationale for combining the references. Yet the Examiner has not provided any evidence that a person of ordinary skill in the art would have combined the references to make such a product. In hindsight, everything is obvious. It seems that a question that should be asked is why the invention (in this example a wheelbarrow) was not already developed. If it is so obvious, then it would seem it already would have been developed.

Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 4-8, 17-21 and 25-29. *Id.*

Furthermore, the Examiner' motivation ("for the benefit of conforming with the operational nature of text windows used by the majority of computer systems to outputting BIOS information") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Crisan to include the missing claim limitations of claims 4, 17 and 25. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 4-8, 17-21 and 25-29. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Crisan addresses the problem of dynamically reconfiguring the boot order when a computer is remotely turned on. Column 3, lines 23-26. The Examiner has not provided any reasons as to why one skilled in the art would modify Crisan, which teaches dynamically reconfiguring the boot order when a computer is remotely turned on, to: (1) remove the configuration of the device from the list if configuration of a device has completed; and (2) display code associated with a configuration of a device immediately previous if the configuration of the device removed in step (d) had its associated code displayed (missing claim limitations of Crisan). The Examiner's motivation ("for the benefit of conforming with the operational nature of text windows used by the majority of computer systems to outputting BIOS information") does not provide such reasoning.

Why would the reason to modify Crisan, whose purpose is to dynamically reconfigure the boot order when a computer is remotely turned on, to (1) remove the configuration of the device from the list if configuration of a device has completed; and (2) display code associated with a configuration of a device immediately previous if the configuration of the device removed in step (d) had its associated code displayed (missing claim limitations of Crisan) be to conform with the operational nature of text windows? What does conforming with the operational nature of text windows have to do with the purpose of Crisan? Further, the Examiner has not

provided any rationale connection between conforming the operational nature of text windows (Examiner's motivation) and (1) removing the configuration of the device from the list if configuration of a device has completed (missing claim limitation of Crisan). Neither has the Examiner provided any rationale connection between conforming the operational nature of text windows (Examiner's motivation) and (2) displaying code associated with a configuration of a device immediately previous if the configuration of the device removed in step (d) had its associated code displayed (missing claim limitation of Crisan). Hence, the Examiner's motivation does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Crisan to include the missing claim limitations of claims 4, 17 and 25. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 4-8, 17-21 and 25-29. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Furthermore, based on the Examiner's stated motivation ("for the benefit of conforming with the operational nature of text windows used by the majority of computer systems to outputting BIOS information"), the Examiner appears to be in essence asserting that since the references can be combined that it would have been obvious to combine Crisan with Lewis. However, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. §2143.01. Hence, the Examiner's stated motivation is insufficient to support a *prima facie* case of obviousness in rejecting claims 4-8, 17-21 and 25-29. *Id.*

> C.   Examiner's motivation for modifying Crisan with Lewis to include the missing claim limitations of claim 22 is insufficient to establish a *prima facie* case of obviousness.

As stated above, most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of

each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that Crisan does not teach "logic for removing said code associated with said first device from said list if said configuration of said first device is completed; and logic for displaying code associated with a second device if said code associated with said first device is displayed, wherein said second device was previously configured to said first device" as recited in claim 22. Office Action (8/9/2006), page 8. The Examiner asserts that Lewis teaches the above-cited claim limitations. Office Action (8/9/2006), page 8. The Examiner's motivation for modifying Crisan with Lewis to include the above-cited claim limitations is "for the benefit of conforming with the operational nature of text windows used by the majority of computer systems to outputting BIOS information." Office Action (8/9/2006), page 9. The Examiner's motivation is insufficient to establish a *prima facie* case of obviousness in rejecting claims 22-24.

The Examiner has not provided a source for his motivation for modifying Crisan to include the above-cited claim limitations. The Examiner simply states "for the benefit of conforming with the operational nature of text windows used by the majority of computer systems to outputting BIOS information" as motivation for modifying Crisan to include the above-cited claim limitations. The motivation to modify Crisan must come from one of three possible sources: the nature of the

problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-48 (Fed. Cir. 1998). Applicants respectfully request the Examiner to point out which of these sources is the source of the Examiner's motivation. The Examiner has not provided any evidence that his motivation comes from any of these sources. Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 22-24. *Id.*

Furthermore, the Examiner' motivation ("for the benefit of conforming with the operational nature of text windows used by the majority of computer systems to outputting BIOS information") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Crisan to include the missing claim limitations of claim 22. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 22-24. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Crisan addresses the problem of dynamically reconfiguring the boot order when a computer is remotely turned on. Column 3, lines 23-26. The Examiner has not provided any reasons as to why one skilled in the art would modify Crisan, which teaches dynamically reconfiguring the boot order when a computer is remotely turned on, to: (1) remove the code associated with the first device from the list if the configuration of the first device is completed; and (2) display code associated with a second device if the code associated with the first device is displayed, where the second device was previously configured to the first device (missing claim limitations of Crisan). The Examiner's motivation ("for the benefit of conforming with the operational nature of text windows used by the majority of computer systems to outputting BIOS information") does not provide such reasoning.

Why would the reason to modify Crisan, whose purpose is to dynamically reconfigure the boot order when a computer is remotely turned on, to (1) remove the code associated with the first device from the list if the configuration of the first

device is completed; and (2) display code associated with a second device if the code associated with the first device is displayed, where the second device was previously configured to the first device (missing claim limitations of Crisan) be to conform with the operational nature of text windows? What does conforming with the operational nature of text windows have to do with the purpose of Crisan? Further, the Examiner has not provided any rationale connection between conforming the operational nature of text windows (Examiner's motivation) and (1) removing the code associated with the first device from the list if the configuration of the first device is completed; and (2) displaying code associated with a second device if the code associated with the first device is displayed, where the second device was previously configured to the first device (missing claim limitations of Crisan). Hence, the Examiner's motivation does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify Crisan to include the missing claim limitations of claim 22. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 22-24. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

Furthermore, based on the Examiner's stated motivation ("for the benefit of conforming with the operational nature of text windows used by the majority of computer systems to outputting BIOS information"), the Examiner appears to be in essence asserting that since the references can be combined that it would have been obvious to combine Crisan with Lewis. However, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. §2143.01. Hence, the Examiner's stated motivation is insufficient to support a *prima facie* case of obviousness in rejecting claims 22-24. *Id.*
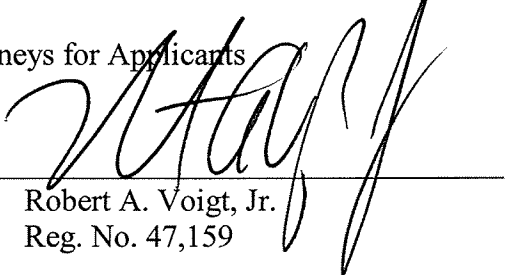
V.   CONCLUSION:

As a result of the foregoing, it is asserted by Applicants that claims 4-8 and 17-29 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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